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ROPES & GRAY LLP
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NEW YORK, NY 10036-8704

EXAMINER	
LONG, FONYA M	

ART UNIT	PAPER NUMBER
3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/991,223	SLATE ET AL.	
	Examiner	Art Unit	
	FONYA LONG	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,51-56,101-106 and 151-177* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,51-56,101-106 and 151-177* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This communication is a third Non-Final Office Action rejection on the merits in response to communications received on April 17, 2009. Claim 1 has been amended. Claims 7-50, 57-100, and 107-150 have been cancelled. Claims 1-6, 51-56, 101-106, and 151-177 are currently pending and have been addressed below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6 and 151-159 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As clarified in Bilski, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

As per Claims 1-6 and 151-159, recite a first and second computer being used for simply data manipulation such as receiving and displaying information, which is considered to be an insignificant extra-solution activity.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-6, 51-56, 101-106, 152-159, 161-168, and 170-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (6,766,307) in view of Pomerance (7,529,679).

As per Claim 1, Israel et al. discloses a method comprising:

receiving an indication from the user to create a profile from a user input device at a first computer, wherein the profile comprises dispute resolution-relating information associated with the user and a dispute (Col. 9, Lines 16-67, via the user registering via inputting relevant biographical information. The use also inputting data relating to a dispute.);

prompting the user at the first computer to select one of the determined dispute resolution paths;

receiving the selection using the user input device at the first computer; and

in response to receiving the selection at the second computer, initiating the selected dispute resolution path (Col. 4, Lines 31-36; Col. 19, Lines 1-25, discloses the user being prompted to select of mode of non-judicial dispute resolution (i.e. a dispute resolution path). In response to receiving the selection by the user, the system initiates the selected mode of dispute resolution.).

However, Israel et al. fails to explicitly disclose determining a sub-plurality of dispute resolution paths; determining estimated dispute resolution information; and displaying the plurality of steps for the determined dispute resolution paths and the estimated dispute resolution information.

Pomerance discloses an automated alternative dispute resolution method and system with the concept of in response to receiving the profile information at a second computer, determining a sub-plurality of dispute resolution paths for resolving the dispute from a plurality of dispute resolution paths based on the profile, wherein each if the dispute resolution paths comprises a plurality of steps for implementing at least one dispute resolution mechanism (Col. 3, Lines 52-62; Col. 5, Lines 10-22, discloses in response to receiving a complaint, determining the relevant procedural (i.e. dispute resolution paths) information relevant to the customer); determining estimated dispute resolution information at the second computer for each of the determined dispute resolution paths based on the profile (Col. 5, Lines 10-22, via providing an estimate of a reasonable time frame and the automatic notification that the customer can expect); and displaying on a display device at the first computer the plurality of steps for the determined dispute resolution paths for resolving the dispute and the estimated dispute

resolution information (Col. 3, Lines 52-62; Col. 5, Lines 10-22, discloses providing the customer how the dispute resolution process works and where more information can be obtained, provides an estimate of a reasonable time frame and the automatic that customer can expect).

Therefore, from the teaching of Pomerance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method for providing complete non-judicial dispute resolution management of Israel et al. to include determining a sub-plurality of dispute resolution paths; determining estimated dispute resolution information; and displaying the plurality of steps for the determined dispute resolution paths and the estimated dispute resolution information as taught by Pomerance in order to in providing an efficient and economical means of resolving disputes in a non-judicial manner.

As per Claims 51 and 101, Israel et al. discloses a system comprising:

a user input device, a display device (means for displaying) (Col. 7, Lines 43-51; Col. 8, Lines 48-57, discloses the user being capable of inputting information via a the web side, wherein the web browser of the user is resident within a user terminal which has a CPU, monitor (i.e. display device), keyboard, and mouse);

means for receiving an indication from the user to create a profile from a first computer, wherein the profile comprises dispute resolution-related information associated with the user and a dispute (Col. 9, Lines 16-67, via the user registering via inputting relevant biographical information. The use also inputting data relating to a dispute.);

means for prompting the user at the first computer to select one of the determined dispute resolution paths;

receiving the selection using the user input device at the first computer; and

in response to receiving the selection at the second computer, means for initiating the selected dispute resolution path (Col. 4, Lines 31-36; Col. 19, Lines 1-25, Col. 9, Lines 56-67, discloses the system being a computer-based architecture for conducting non-judicial dispute resolution wherein the user is prompted to select of mode of non-judicial dispute resolution (i.e. a dispute resolution path). In response to receiving the selection by the user, the system via the management module initiates the selected mode of dispute resolution.).

However, Israel et al. fails to explicitly disclose means for determining a sub-plurality of dispute resolution paths; means for determining estimated dispute resolution information; and means for displaying the plurality of steps for the determined dispute resolution paths and the estimated dispute resolution information.

Pomerance discloses an automated alternative dispute resolution method and system with the concept of in response to receiving the profile information at a second computer, means for determining a sub-plurality of dispute resolution paths for resolving the dispute from a plurality of dispute resolution paths based on the profile, wherein each if the dispute resolution paths comprises a plurality of steps for implementing at least one dispute resolution mechanism (Col. 2, Line 65-Col. 3, Line 62; Col. 5, Lines 10-22, discloses a user connected to the system via a general purpose computer having web browser software that connects to the system via the Internet. The system being a

general purpose computer programmed to perform the dispute resolution process, wherein in response to receiving a complaint, determining the relevant procedural (i.e. dispute resolution paths) information relevant to the customer); means for determining estimated dispute resolution information at the second computer for each of the determined dispute resolution paths based on the profile (Col. 2, Line 65-Col. 3, Line 62; Col. 5, Lines 10-22, discloses a user connected to the system via a general purpose computer having web browser software that connects to the system via the Internet. The system being a general purpose computer programmed to perform the dispute resolution process, wherein the system provides an estimate of a reasonable time frame and the automatic notification that the customer can expect); and means for displaying on a display device at the first computer the plurality of steps for the determined dispute resolution paths for resolving the dispute and the estimated dispute resolution information (Col. 2, Line 65-Col. 3, Line 62; Col. 5, Lines 10-22, discloses a user connected to the system via a general purpose computer having web browser software that connects to the system via the Internet. The system being a general purpose computer programmed to perform the dispute resolution process, wherein the system provides the customer how the dispute resolution process works and where more information can be obtained, provides an estimate of a reasonable time frame and the automatic that customer can expect).

Therefore, from the teaching of Pomerance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method for providing complete non-judicial dispute resolution management of Israel et

al. to include determining a sub-plurality of dispute resolution paths; determining estimated dispute resolution information; and displaying the plurality of steps for the determined dispute resolution paths and the estimated dispute resolution information as taught by Pomerance in order to in providing an efficient and economical means of resolving disputes in a non-judicial manner.

As per Claims 2, 52, and 102, Israel et al. discloses wherein the mechanism is selected form the group consisting of documents-only arbitration and on-call mediation (Col. 19, Lines 9-37, discloses mediation and/or arbitration options wherein the mediation and/or arbitration can be real-time online mediation or arbitration, or off-line mediation or arbitration. The parties submit arguments, information, proof, and any other evidence to be considered by the mediator or arbitrator via the Internet. When the process is done in real time, the mediator or arbitrator can request additional information or explanation from a party (i.e. on-call), should further information or explanation be required).

As per Claims 3, 53, and 103, Israel et al. discloses determining whether the user has met a predetermined standard for conducting business (Col. 27, Lines 12-21, via determining whether the parties have agreed to the terms of the Negotiation Agreement in order to be allowed to enter demands and offers onto the system); and providing the user with a certification in response to meeting the predetermined standard (The term certification is defined as to attest authoritatively or to inform to certainty via *"certifying."* *Merriam-Webster Online Dictionary. 2009. Merriam-Webster Online, 2 August 2009, http://www.merriam-webster.com/dictionary/certifying.*Col. 27,

Lines 12-21, disclose certifying that both parties will be bound by the terms and conditions of the Negotiation Agreement).

As per Claims 4, 54, 104, 155, 164, and 173, Israel et al. discloses the claimed invention as applied to Claims 1, 51, and 101. However, Israel et al. fails to explicitly disclose calculating a cost for resolving the dispute using each of the determined dispute resolution paths.

Pomerance discloses an automated alternative dispute resolution method and system with the concept of calculating a cost for resolving the dispute (Col. 8, Line 61-Col. 9, Line 3, discloses determining the fees for mediation (i.e. resolving a dispute)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the non-judicial dispute resolution system of Israel et al. the cost calculation taught by Pomerance since this provides an efficient way for the parties to choose the rules, regulations, and procedures which will apply in the dispute resolution process. The Examiner asserts that using an average cost of similar disputes is routinely dome in any business practice. For example, attorneys on a daily basis provide clients with information as to an estimate for taking case to trial versus trying to settle the case out of court. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an average cost when calculating a cost since this is generally how businesses operate.

As per Claims 5, 55, and 105, Israel et al. discloses the claimed invention as applied to Claims 1, 51, and 101. However, Israel et al. fails to explicitly disclose

determining an estimated time for resolving the dispute using each of the determined dispute resolution paths.

Pomerance discloses an automated alternative dispute resolution method and system with the concept of determining an estimated time for resolving the dispute using each of the determined dispute resolution paths (Col. 2, Line 65-Col. 3, Line 62; Col. 5, Lines 10-22, discloses providing an estimate of a reasonable time frame and the automatic that customer can expect).

Therefore, from the teaching of Pomerance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method for providing complete non-judicial dispute resolution management of Israel et al. to include determining an estimated time for resolving the dispute using each of the determined dispute resolution paths as taught by Pomerance in order to in providing an efficient and economical means of resolving disputes in a non-judicial manner.

As per Claims 6, 56, and 106, Israel et al. discloses the claimed invention as applied to Claims 5, 55, and 105. However, Israel et al. fails to explicitly disclose comparing the dispute to a plurality of past disputes.

Pomerance discloses an automated alternative dispute resolution method and system with the concept of comparing the dispute to a plurality of past disputes (Col. 2, Line 65-Col. 3, Line 62; Col. 5, Lines 10-22, discloses comparing the dispute to a plurality of past disputes via identify prior case information that is relevant to the customer's dispute. Examiner asserts it would have been obvious to one of ordinary skill

in the art at the time the invention was made to use the prior case information to determine the estimated time frame for resolving a dispute.).

Therefore, from the teaching of Pomerance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method for providing complete non-judicial dispute resolution management of Israel et al. to include comparing the dispute to a plurality of past disputes as taught by Pomerance in order to in providing an efficient and economical means of resolving disputes in a non-judicial manner.

As per Claims 152, 156, 161, 165, 170, and 174, Israel et al. discloses wherein a first determined dispute path implements at least two dispute resolution mechanisms (Col. 4, Lines 31-36; Col. 19, Lines 1-25, discloses user may selected the negotiation path or the mediation/arbitration paths, wherein the mediation/arbitration paths implement two dispute resolution mechanisms (i.e. online or offline) and the negotiation path implements two dispute resolution mechanisms (i.e. "blind bid: or an "open bid" type of negotiation).

As per Claims 153, 154, 162, 163, 171, and 172, the Israel et al. and Pomerance combination discloses the claimed invention as applied to Claims 1, 51, and 101. However, the combination fails to explicitly disclose that the dispute resolution path is based on the size of the dispute amount or the relationship between the user and a disputing party.

The Examiner asserts that one of ordinary skill in the art would take into account the size of the dispute amount when determining the type of dispute resolution to take.

For example, if the dispute amount is small, the user may decide to do negotiations instead of litigation, since the litigation costs could outweigh the dispute amount or reduce the amount awarded to the user after litigation costs have been paid minimal.

The Examiner also asserts that one of ordinary skill in the art would take into account the relationship of the parties in determining a path for dispute resolution. For example, if the two parties disputing are really angry with each other such that it becomes impossible to negotiate or mediate, the arbitration or litigation would be the preferred path. However, if the two parties are amicable and may have to maintain contact with each other, for example, a couple in a divorce with children, then the preferred path may be negotiation or mediation rather than arbitration.

Therefore, the Examiner asserts that one of ordinary skill in the art at the time the invention was made would take into account the size of the dispute amount and the relationship of the parties since this information is used daily by those in the legal community to make recommendations to their clients. Common sense dictates that one uses this information to make a determination of which dispute resolution path to recommend.

As per Claims 157, 166, and 175, Israel et al. discloses the first determined dispute resolution path will move from a first dispute mechanism to a second dispute mechanism only when the first dispute mechanism does not result in a resolution (Col. 5, Lines 44-51, via an election by one or more parties to move to a different non-judicial dispute resolution procedure because the first method chosen has not succeeded).

As per Claims 158, 167, and 176, Israel et al. discloses the first determined dispute resolution path moving from a first dispute mechanism to a second dispute mechanism when the first dispute mechanism does not result in a resolution (Col. 5, Lines 44-51, via an election by one or more parties to move to a different non-judicial dispute resolution procedure because the first method chosen has not succeeded).

However, Israel et al. fails to explicitly disclose this process being done without any user intervention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to moving from a first dispute mechanism to a second dispute mechanism without any user intervention, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

As per Claims 159, 168, and 177, Israel et al. discloses a first determined dispute resolution path implements documents only arbitration and a second determined dispute resolution path implements on call mediation followed by arbitration (Col. 19, Lines 9-37, discloses mediation and/or arbitration options wherein the mediation and/or arbitration can be real-time online mediation or arbitration, or off-line mediation or arbitration. The parties submit arguments, information, proof, and any other evidence to be considered by the mediator or arbitrator via the Internet. When the process is done in real time, the mediator or arbitrator can request additional information or explanation from a party (i.e. on-call), should further information or explanation be required).

5. Claims 151, 160, and 169 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (6,766,307) in view of Pomerance (7,529,679), and applied to Claims 1, 51, and 101 above, and in further view of Sloo (5,895,450).

As per Claims 151, 160, and 169, the Israel et al. and Pomerance combination discloses the claimed invention as applied to Claims 1, 51, and 101 above. However, the combination fails to explicitly disclose providing success rate information for similar disputes resolved.

Sloo discloses a method and system for handling complaints with the concept of providing success rate information for similar disputes resolved (Col. 8, Lines 50-58, discloses providing success rate information by rating the parties involved in disputes wherein the rating or score for the prevailing party is increased, while the rating or score for the losing party is decreased. Col. 10, Line 54-Col. 11, Line 5, discloses using the rate information (i.e. gathered information) to predict (i.e. estimate) the outcome for the present situation.).

Therefore, from the teaching of Sloo, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Israel et al. and Pomerance combination to include providing success rate information for similar disputes resolved as taught by Sloo in order to aid a user in determining which mode of dispute resolution would be most beneficial.

Response to Arguments

6. Applicant's arguments filed April 17, 2009 have been fully considered but they are not persuasive.

Applicant's arguments, see "Remarks", filed April 17, 2009, with respect to the rejection(s) of claim(s) 1, 3-5, 51, 53-55, 101, 103-105, 152-159, 162-168, 170, 172-177 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Israel et al. (6,766,307) and Pomerance (7,529,679).

As per Claims 151, 160, and 169, Applicant argues that Sloo fails to disclose "providing success rate information for similar dispute resolved". Examiner respectfully disagrees. Examiner asserts Sloo discloses calculating a rating or score for each party of a dispute, wherein the rating or score for the prevailing party is increased, while the rating or score for the losing party is decreased (Col. 8, Lines 50-58). Sloo also discloses using the rate information (i.e. gathered information) to predict (i.e. estimate) the outcome for the present situation (Col. 10, Line 54-Col. 11, Line 5). Examiner asserts that a dispute may be interpreted to be "similar" because it involves at least of the same parties in which a rating is provided.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689